

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



First Named Applicant: Rillie) Art Unit: 3634
Serial No.: 09/376,461)) Examiner: Cohen
Filed: August 18, 1999)) 1128.006A
For: SKYLIGHT FLASHING)) June 18, 2003
)) 750 B Street, Suite 3120
)) San Diego, CA 92101
))

AP/3634
H2B
OP
06/25/03

TRANSMITTAL LETTER FOR PETITION TO THE COMMISSIONER

Commissioner for Patents
Alexandria, VA 22313

Dear Sir:

In response to the Advisory Action dated June 6, 2003, enclosed herewith are the following:

- (1) A Petition To The Commissioner
- (2) A check totalling \$130 to cover the petition fee
- (3) Acknowledgment postcard.

RECEIVED

JUN 24 2003

GROUP 3600

Respectfully submitted,

John L. Rogitz, Attorney of Record
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CERTIFICATE OF MAILING

Refund Ref: 04/28/2004 PFARRIER 000013594I hereby certify that this correspondence is being deposited with the United States Postal Service, First-Class Mail, postage fully prepaid, under 37 CFR 1.8, addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA on JUNE 18, 2003.

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Date Signed: JUNE 18, 2003

JOHN L. ROGITZ, Attorney of Record
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Rillie) Art Unit: 3634
Serial No.: 09/376,461)
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PETITION

Commissioner of Patents and Trademarks
Washington, DC 20231

JUN 24 2003

GROUP 3600

Dear Sir:

This might be called a "petition *from* a suspension of the rules". Owing to the fact that the complained-of conduct evidently was vetted by the Group Director and who should thus properly recuse himself, it is respectfully suggested that this Petition be decided by the Assistant Commissioner's office.

The Commissioner is invited to consider whether prosecution can be properly reopened for a new search after a Board reversal of all previous rejections, when the Board did not indicate a remand for a new search in its prior decision. The examiner, who was not the examiner originally appealed, purports compliance with MPEP §1214.04. However, this section explicitly states that

"The examiner should *never* regard such a [Board] reversal as a challenge to make a new search to uncover other and better references. *This is particularly so where the application has been transferred to an examiner other than the one who rejected the claims leading to appeal. The second examiner should give full faith and credit to the prior search*" (emphasis mine).

1128-6.PET
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How conducting a new search in this instance comports with the above language is indeed mysterious.

The examiner next relies on MPEP §704.01, but has appeared to overlook the fact that Chapter 700 applies to general examination pre-appeal, and that it cannot take precedence over contrary guidance in Chapter 1200 that is specifically directed to post-appeal action. Moreover, the relied-upon section of Chapter 700 again repeats that full faith and credit are to be given to a prior examiner's search, unless there is clear error in the action taken or knowledge of the prior art. The examiner now evidently contends there was such clear error, but without elaborating on what it might have been. The "clear error" being complained of presumably is not of the action taken, because the "action taken" would refer to the reversal by the Board. And, no evidence has been presented as to why the examiner and the Board clearly erred in their knowledge of the prior art. Indeed, the Board's thorough opinion reversing the prior rejections evidences a keen understanding of the prior art. Reliance on this section of the MPEP for the examiner's behavior thus appears to be misplaced.

The examiner then attempts to make two lawyerly arguments about MPEP §1214.04 which, like many such arguments, are too clever by half. He first argues that the third paragraph "provides clear authority" to reopen prosecution. Indeed it does, but only under limited circumstances that the examiner fails to mention, namely, when the examiner has *specific* knowledge of references indicating unpatentability. Despite the examiner's representation to the contrary, this was plainly not the case here, since the new references being applied against Claims 3 and 7 (Clarke et al. and Deutsch et al.) were all uncovered pursuant to a new search that yielded several other new references as well. If the examiner had "specific" knowledge of the three new references, why was a new search required to find them?

The "specific knowledge" proviso of the third paragraph does indeed make sense, however, when one reads it, in conjunction with the preceding prohibition against a new search, to permit the assertion of references that the examiner specifically knows of without having to dig them up from a search, e.g., patents currently before the examiner in another case. Otherwise, reading it as advocated by the examiner more or less has the effect of eliminating from the MPEP the above-quoted guidance against more searching post-decision absent a remand to do so.

The examiner then plays a little word game, noting that MPEP §1214.04 doesn't really prohibit a new search, it only prohibits an examiner from feeling "challenged" to perform one. This of course reduces the MPEP from an objective source of procedural authority to an advisory document the compliance with which depends on an examiner's subjective state of mind and discretionary proclivity to engage in semantics. The fact that this argument is being made at all demonstrates the bankruptcy of the examiner's purported support for authority to do what he did.

The examiner concludes his rationalizing with the observation that "in any event, if the claimed subject matter is unpatentable, applicant is not entitled to it under any circumstances." This bears more than a whiff of pleading that the end justifies the means, a particularly unfortunate attitude in a federal agency whose permissible conduct is supposed to be clearly authorized in writing, not merely hinted at or justified after the fact as a fait accompli. What Appellant is arguing here is not the substantive merits of the new art uncovered during the search, which are dealt with in the Supplemental Appeal Brief, but conduct by a Patent Office employee that plainly finds no clear authorization in the Patent Office's own procedures and that, if anything, appears to be discouraged by the MPEP.

CASE NO.: 1128.006A
Serial No.: 09/376,461
June 16, 2003
Page 4

PATENT
Filed: August 18, 1999

It may be that despite MPEP Chapter 1200, the Patent Office favors new searching after a Board reversal without remand for a search. It may also be that although Appellant believes the examiner's rationale is on shaky ground, the Commissioner may agree with it. If that is the case, it nonetheless should be indisputable that in light of the above-discussed sections of the MPEP, the MPEP is less than clear on this point. In that event, it is respectfully suggested that the MPEP be amended to clearly state that an examiner may conduct a new search after a Board reversal without remand to do so, so that the public has fair notice that such conduct might be expected.

Respectfully submitted,



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